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Brian Andrew Phillips

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

NOTIFICATION DATE

DELIVERY MODE

07/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 1/3/2008, which was received 3/7/2008. Acknowledgement is made to the amendment to claim 16, leaving claims 16-20 as open to prosecution. Applicant's amendment has been carefully considered and was found to be persuasive therefore the USC 112 rejection has been obviated, however in regards to the rejection on the merits, after further search and consideration a new ground of rejection is provided below:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiloh (US PG PUB 2001/0037316) and further in view of Lussow et al (US PG PUB 2004/015553424).

In regards to claim 16, Shiloh discloses a system comprising:

a web server (FIG 1, item 15); and

an integrated shipping server hosted by a third party payment service, linked in communication with the web server (FIG 2, item 34),

the web server and integrated shipping server, acting as an intermediary server between a sender and a shipping vendor (FIG 2), comprising

software instructions that when executed enable the sender to arrange for shipment of a package to a recipient via the shipping vendor by performing operations, by the integrated shipping server (para 0090), including:

generating and serving web pages via which shipping information including sender address may be automatically entered into the web pages (para 0085 and 0087), and

interacting with an on-line interface hosted by the shipping vendor to arrange for shipment of the package via the shipping vendor through use of the shipping information (para 0085 and 0087 and 0090);

receiving shipping data pertaining to the shipment from the shipping vendor (para 0090),

Shiloh teaches sending shipping data to a shipper, but does not specifically mention that the shipping data is a shipping label served via a web page that can be printed, Lussow teaches shipping data is a shipping label served via a web page that can be printed (Lussow, para 0071). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shiloh returning a shipping label that can be printed out, because this will increase efficiency by providing the label electronically rather than mailing or having the sender pick up the label, thus saving time and aggravation on the part of the sender.

In regards to claim 17, the combination of Shiloh and Lussow, teach a payment server linked in communication with the integrated shipping server and comprising further software instructions that when executed perform the operation of facilitating payment for the shipment from the seller to the shipping vendor (Lussow, para 0007 and 0055).

In regards to claim 18, the combination of Shiloh and Lussow teach wherein the system is configured to be operable by a third-party payment service for which the seller has an account, and facilitating payment of the shipment comprises:

providing payment from the third-party service to the shipping vendor; and deducting a shipping cost of the shipment from the seller's third-party payment service account (Lussow para 0055)).

In regards to claim 19, the combination of Shiloh and Lussow teach wherein payment from the third-party service to the shipping vendor is facilitated via interaction between the payment server and a debit/credit card authorization/settlement network (Lussow para 0055 and Shiloh 0026,0028, 0033).

In regards to claim 20, the combination of Shiloh and Lussow teaches generating a virtual debit card; and employing the virtual debit card to pay the shipping vendor (Shiloh, para 0026 and FIG 2).

Further in regards to claims 17-20 and the combination of Shiloh and Lussow, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art. Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Response to Arguments

Applicant's arguments with respect to claims 10-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

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or faxed to:

Art Unit: 3625

571-273-8300

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Primary Examiner, Art Unit 3625